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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,860	11/28/2001	Ronald D. Blum	027001-000310US	9812
20350 7590 03/03/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BOECKMANN, JASON J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of:
BLUM, RONALD D. et al
Appl. No.: 09/994,860
Filed: Nov. 28, 2001
Attorney Docket No: 027001-000310US
For: METHOD AND APPARATUS FOR REDUCING
THE INTENSITY OF HURRICANES AT SEA BY
DEEP-WATER UPWELLING

:
: DECISION ON PETITION

This is a decision on the petition filed on February 16, 2010 by which petitioner requests supervisory review and withdrawal of the finality of the office action dated December 15, 2009. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

A review of the relevant prosecution history shows that the applicant filed an RCE on September 13, 2009 with only an addition of a new claim 37 which is directed to a distinct or independent invention (MPEP § 806.05h). The previous presented claims 1-17 and 33-36 under the previous final rejection of July 24, 2008 were not amended at all. The RCE of September 13, 2009 also includes IDS which contains sixteen published patents and applications and thirteen publications. The RCE was properly filed in accordance with the 35USC 132(b) and MPEP § 706.07(h). On December 15, 2009, the examiner issued a first Office action final rejection to the RCE. The examiner finally rejected claims 1-17 and 33-36 under applicable sections of 35 USC §101 and § 112. However, the examiner did withdraw the newly added claim 37 from consideration due to constructive non-elected invention under MPEP § 821.03. Moreover, under MPEP § 706.07(h), applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the previously claimed and examined as a matter of right (i.e. applicant cannot switch inventions). The withdrawal of non-elected claim 37 is deemed proper. Upon further review of the final Office action of December 15, 2009, this final rejection is the first office action based on the same identical grounds of the previous final rejection of July 24, 2008. These two final rejections are almost verbatim. In response to the first final Office action mailed July 24, 2008, the applicant filed a Notice of Appeal and Appeal Brief on October 15, 2008. Subsequently, on January 9, 2009, the examiner issued an Examiner's Answer. Upon

receipt of a Reply Brief, on April 21, 2009, the examiner forwarded the case to the Board of Appeals and Interferences.

On February 16, 2010, petitioner filed the current petition requesting supervisory review of the propriety of the final rejection and withdrawal of the finality of the Office action dated December 15, 2009. The petitioner is of the opinion that first Office action final rejection of December 15, 2009 is improper under MPEP 706.07(b) because petitioner believes these sections of the MPEP provide a framework where new information may be submitted for consideration with an RCE, and the Office will not make final on the next Office Action after the submission of such information. Therefore, petitioner opines that the IDS submitted to the Office should be properly addressed in a non-final action and the finality of the rejection is improper on its face because the claims could not have been properly finally rejected on the grounds and art of record prior to the filing of the RCE, because the art of record with respect to the 101 and 112 rejections has changed based on Applicant's IDS, which contained references germane to the credible utility of the claimed subject matter.

Analysis of Application Record

The record shows that the examiner has determined that the submission and amendment of September 3, 2009 RCE did not add any new limitations to previously rejected claims 1-17 and 33-36. The unamended claims 1-17 and 33-36 remain directed to same invention with no change in scope of what was previously claimed. A comparison of the final Office action of December 15, 2009 and the previous final rejection of July 24, 2008 indicates that two final rejections are almost identical. In the final Office action of December 15, 2009, the examiner also considered the IDS filed with the RCE¹ and determined that the unamended claims 1-17 and 33-36 remain unpatentable for the same grounds of rejection under 35 USC 101 and 112. In particular, on page 7 of the final Office action of December 15, 2009, the examiner has determined that the claims 1-17 and 33-36 presented with the RCE were drawn to the same invention as claimed in the amendment filed on April 28, 2008 and that the claims could have been finally rejected on the same grounds previously of record. Based on the analysis of record, when the examiner promulgated the first Office action as final rejection of December 15, 2009, the conditions set forth in MPEP 706.07(b) were met. Thus, the examiner's final rejection after RCE based on the same grounds of rejection of record pursuant to MPEP § 706.07(b)² is proper.

¹ MPEP 706.07(h) states: The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP §706.07(b) for making a first action final in a continuing application are met.

² MPEP 706.07(b), paragraph 2 states: The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114.<

Petitioner's argument regarding the examiner's failure to consider the IDS filed with the RCE is incorrect. There is no evidence showing that the examiner has failed to consider the IDS filed by the applicant's. As to the contrary, the examiner in fact did consider the IDS filed with the RCE as evidenced by his initials on the IDS returned to the applicant in his final rejection of December 15, 2009. It appears from the record that the examiner has fully considered all sixteen published applications and patents, along with thirteen articles and publications in accordance with MPEP § 609 (see PTO Forms 1449). Petitioner fails to point out exactly which prior art reference(s) that the examiner has not considered and initialed. It is also noted that the applicant has failed to point out the relevance of each and every cited prior art references as listed on the Forms 1449 for the examiner to address and comment. Therefore, there is nothing for the examiner to agree and disagree with the cited prior art references. Since the examiner has considered and initialed the Forms 1449 pursuant to MPEP § 609, there is no need to further articulate any specific consideration of the same IDS. Again, it appears from the record that after the examiner has considered the cited prior art references as listed on the Forms 1449, the examiner remains convinced that the unamended claims 1-17 and 33-36 are still unpatentable under 35 USC § 101 and § 112. Since the IDS have been made of record in this case and there is no change of rejections at all, the applicant may wish to re-instate the appeal process by filing a new notice of appeal and an appeal brief.

Conclusion

Based on the analysis of record, when the examiner promulgated the first office action final rejection of December 15, 2009, the conditions set forth in MPEP 706.07(b) were met. In particular, the unamended claims 1-17 and 33-36 in the amendment of September 3, 2009 in fact are directed to the same invention of the claims in the earlier amendment. The claims in the amendment of September 3, 2009 would have been properly finally rejected on the same grounds of record in the next Office action if they had been presented. Therefore, under MPEP 706.07(b) the first action final rejection appears to be proper.

For the foregoing reasons, it appears that the examiner's decision to make the Office action dated December 15, 2009 final was neither arbitrary nor capricious, and that the examiner's action was in accordance with the guidance set forth in MPEP 706.07. Accordingly, there appears to be no basis for granting the relief petitioner requests.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3752 awaiting for filing of notice of appeal and appeal brief. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181".

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

The petition is DISMISSED.

A handwritten signature in black ink, appearing to read 'Don - Hajec', written over a horizontal line.

Donald T. Hajec, Director
Technology Center 3700